

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Evan Pennell et al.	Art Unit	: 3724
Serial No.	: 10/798,864	Examiner	: Stephen Choi
Filed	: March 11, 2004	Conf. No.	: 6604
Title	: SHAVING RAZORS AND OTHER HAIR CUTTING ASSEMBLIES		

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY BRIEF

Pursuant to 37 C.F.R. § 41.41, Appellants respond to the Examiner's Answer as follows:

At page 9, lines 11-13, page 10, line 6 – page 11, line 8, page 11, lines 18-20, page 12, lines 6-13, and page 14, lines 16-18, the Examiner newly asserts that “it is appropriate for the examiner to rely solely on the rationale used by the court to support an obviousness rejection” because the appellants did not “provide evidence of nonobviousness.” The Examiner contends that *Nerwin v. Erlichman*, 168 USPQ 177, 179 (Bd. Pat. App. & Int. 1969), stands for the proposition that it is obvious to construct “formerly integral structure[s]” out of various elements. See Examiner's Answer, page 4, lines 5-7. *Nerwin*, however, is a BPAI decision from 1969 and “reflects a discredited *per se* rule for obviousness and cannot be relied upon as support for [an] obviousness rejection.” See BPAI decision in Appeal Number 2008-0092, U.S. Patent Application No. 10/192,169, page 4, decided March 18, 2008. There are no *per se* rules for obviousness; instead the analysis of obviousness must stem from the specific facts. *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (“The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-including all its limitations-with the teachings of the prior art, flouts section 103 and the fundamental case law applying it.”). Here the Examiner has not provided any reason specifically addressing facts surrounding the prior art. Asserting that one would have made the alteration in order “to arrive at the claimed invention” is also not a legally sufficient reason. As such, the Examiner's statements clearly indicate the use of hindsight analysis and are examples of the types of conclusory statements that cannot support a conclusion of obviousness. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Because the rejections do not provide any reason that supports a conclusion of obviousness,

other than a reference to a discredited *per se* rule, the rejections are in error and should be withdrawn.

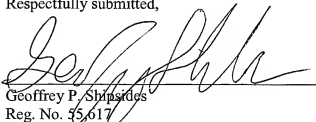
The Examiner also incorrectly alleges that the Examiner does not need to provide any reason, other than "the rationale used by the court to support an obviousness rejection" regarding the selection of material where "the appellants have failed to provide evidence of nonobviousness." See Examiner's Answer, page 14, lines 12-16. Again, the Examiner is relying on a *per se* rule, rather than actually providing a reason why one having ordinary skill in the art would have made the modification. Furthermore, Appellants have already demonstrated how the examiner is making a non-standard interpretation of the prior art and how the interpretation requires the Examiner to assert the modification of a top part of the housing of the prior art to be made of sheet metal while the remainder remains plastic. This is not the type of modification that one having ordinary skill in the art would have made. As *KSR* stressed, the "apparent reason to combine the known elements in the fashion claimed by the patent at issue" should be made explicit in order "[t]o facilitate review." *KSR*, 127 S.Ct. at 1741. Because the Examiner has not made explicit any reason for the alleged modification, other than relying on discredited *per se* rules, the rejections cannot be maintained.

For these reasons, and the reasons stated in the Appeal Brief, Appellants submit that the final rejection should be reversed.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 8/29/2008


Geoffrey P. Shippides
Reg. No. 35,617

Fish & Richardson P.C.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402
Telephone: (612) 335-5070
Facsimile: (612) 288-9696